

REMARKS

Applicant respectfully requests that the above amendments be entered at least because the amendments raise no new issues requiring further search or consideration and because they place the application in condition for allowance.

Claims 1-3 are currently being amended. New claims 8-10 are being added. New claims 8-10 correspond to new claims 1-3, respectively, but are broader than their corresponding claims. No new matter has been added.

This amendment changes and adds claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-10 are now pending in this application.

Rejections under 35 U.S.C. § 103

Claims 1-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,640,452 to Murphy (hereafter "Murphy") in view of U.S. Patent No. 5,530,754 to Garfinkle (hereafter "Garfinkle"), U.S. Patent No. 6,028,933 to Heer et al. (hereafter "Heer"), JP 0 9035030 A to Kazuyoshi (hereafter "Kazuyoshi"), and U.S. Patent No. 5,944,824 to He (hereafter "He"). Claims 6 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy, Garfinkle, Heer, Kazuyoshi, and He, in further view of "IEEE 1394 High Performance Serial Bus: The Digital Interface for ATM" by Kunzman et al. (hereafter "Kunzman"). Applicant respectfully traverses these rejections for at least the following reasons.

In the systems of claims 1, 2 and 3 the device ID detecting means is configured for detecting, when the transmitting-receiving device on another party (claims 1 and 3), or one of the other parties (claim 2), is connected to a transmission line, a device ID thereof. Murphy fails to suggest such a device ID detecting means.

Murphy does not disclose a device ID detecting means that is configured for detecting, when a transmitting-receiving device on another party is connected to a transmission line, a

device ID thereof, as recited in claims 1-3. Murphy is directed to preventing unauthorized use of a decryption chip 15i in a receiver 13i with a receiver processor 23i. The processor 23i of Murphy, however, stores the location of an authorized site, but does not act to detect a device ID. Moreover, the processor 23i (or any other component) of Murphy clearly does not act to detect a device ID of another party when a transmitting-receiving device on the another party is connected to a transmission line.

Garfinkle does not cure the deficiencies of Murphy. Garfinkle discloses a video on demand system including a number of user sites 18 and a central station 10 (see Fig. 1). A user can transmit video product order data to the central station, where the order data can include data relating to the user (col. 4, lines 59-65). Garfinkle does not disclose, however, that the user data includes a device ID. Thus, even if Garfinkle were combined with Murphy, the combined system would not include a device ID detecting means as recited in claims 1-3.

Moreover, the claims have been amended to clarify that the authenticating means performs a device authentication operation for mutually checking that both said devices are devices based on certain rules and the detected device ID of the transmitting-receiving device on the another party (claims 1 and 3) or on the one of other parties (claim 2). Even if the data relating to a user in Garfinkle were to contain some type of device ID (which it does not), Garfinkle does not suggest that any detected device ID be used in the context of an authenticating means that performs device authentication and then a key exchange operation as in claim 1-3.

The remaining references cited in the rejections were cited for disclosing other claimed features and fail to suggest that the Murphy device should be modified to include a device ID detecting means configured for detecting, when the transmitting-receiving device on another party (or one of the other parties) is connected to a transmission line, a device ID thereof. Thus, the remaining references cited in the rejections do not cure the deficiencies of Murphy.

Independent claims 1 and 2 also include an authentication histories storing means, and recite that the authenticating means performs a device authentication operation “when said transmitting-receiving device on another party with a history that authentication has been

previously performed therefor is connected to a transmission line.” As correctly recognized in the Office Action, Murphy does not disclose the authentication of devices and the maintenance of an authentication history.

Applicant again submits that one skilled in the art would not have modified the Murphy system to include an authentication histories storing means to arrive at the invention of claims 1 and 2. The Murphy system is for the purpose of determining whether a receiver 13i including a decryption chip 15i is located at an authorized location. There is no need in the Murphy system to include a history of past authentications, which in the Murphy system would be indications of when in the past the receiver was indicated as being in an authorized location, because it is irrelevant to the determining of whether the present location is unauthorized that in the past the location was authorized.

In response the Office Action states on page 2 that the “Murphy reference and the Heer, Kazuyoshi, He and Kunzman references are all in the same field of data network and security and are therefore able to be combined to create a system as disclosed in the rejection below.” Applicants note that the test for obviousness based on multiple reference is not whether the references are merely able to be combined. *See MPEP 2143.01* (The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desireability of the combination.” *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). In the present case, as discussed above, there is simply no need in the Murphy system to include a history of past authentications, and the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness.

For at least the above reasons, claims 1-3 are patentable over Murphy, Garfinkle, Heer, Kazuyoshi, He, and Kunzman. Claims 4-7 ultimately depend from one of claims 1 and 2, and are patentable for at least the same reasons, as well as for further patentable features recited therein.

Claims 8-10

New independent claims 8-10, corresponding respectively to claims 1-3, have been added. In a similar fashion to corresponding claims 1-3, in the system of claims 8-10, the device ID detecting means is configured for detecting, when the transmitting-receiving device

on another party (claims 8 and 10), or one of the other parties (claim 9), is connected to a transmission line, a device ID thereof. As discussed above, Murphy and the remaining references cited in the rejections fail to suggest such a device ID detecting means. Claims 8-10 also include first and second authenticating means that perform a device authentication operation for mutually checking that both said devices are devices based on certain rules and the detected device ID of the transmitting-receiving device on the another party (claims 8 and 10) or on the one of other parties (claim 9). As discussed above, the references cited in the above rejections fail to disclose any means that performs such a function.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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